UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,434	03/26/2004	Hajime Inada	119284	8100

25944 7590 03/24/2008

OLIFF & BERRIDGE, PLC
P.O. BOX 320850
ALEXANDRIA, VA 22320-4850

EXAMINER	
PARK, CHAN S	

ART UNIT	PAPER NUMBER
2625	

MAIL DATE	DELIVERY MODE
03/24/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/809,434	INADA, HAJIME	
	Examiner	Art Unit	
	CHAN S. PARK	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 March 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *9-13* is/are allowed.

6)☒ Claim(s) *1,2,4,5,7,8,14-19 and 22-24* is/are rejected.

7)☒ Claim(s) *3,6,20 and 21* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *26 March 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *6/1/06 & 8/6/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 22-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 22-24 are drawn to functional descriptive material NOT claimed as residing on a computer readable medium. MPEP 2106.IV.B.1(a) (Functional Descriptive Material) states:

"Data structures not claimed as embodied in a computer-readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer."

"Such claimed data structures do not define any structural or functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized."

Also, refer to page 53 of the Interim Guideline.

Claims 22-24, while defining a storage medium, do not define a "computer-readable medium" and is thus non-statutory for that reason. A storage medium can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to state, "A computer-readable medium encoded with a computer program..." in order to make the claim statutory.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 4, 5, 14, 15, 19, 22 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Bobo U.S. Patent No. 6,350,066.

With respect to claim 1, Bobo discloses a communication system (message storage and delivery system 10 in fig. 1) comprising:

an image storing unit that stores image data (storing message data in col. 8, lines 5-7) transmitted or received through facsimile communications (note that the message data is fax data in col. 7, lines 60-64);

a page generating unit that generates a list page, the list page being a web page displaying a list of communication details associated with the image data transmitted or received through the facsimile communications (generating/displaying the list of faxes in thumbnail view in a webpage/HTML files in col. 10, lines 46-56 & col. 9, lines 39-50), the list of communication details including hyperlinks to the associated image data stored in the image storing unit (thumbnail view having the links to the corresponding pages in col. 10, lines 52-56);

a page distributing unit that distributes via a network the list page generated by the page generating unit (system 10 distributing the browser page to the user computer for review in col. 8, lines 23-36); and

an access determining unit that determines whether to allow access to the image data associated with the communication details of the facsimile communication based on contents of the communication details (note that based on the intended recipient of the message in col. 8, line 7, the message is stored in the recipient's database/mailbox for allowing retrieval by the intended recipient in col. 8, lines 23-36),

wherein the page generating unit generates the list page having the hyperlinks only to the image data for which the access determining unit allows access (the mailbox can be only accessed by the intended recipient using the password and ID in col. 8, lines 23-36).

With respect to claim 2, Bobo discloses the communication system according to claim 1, wherein the communication details include at least a transmission source and transmission destination of the image data (identifying the intended recipient in col. 8, line 7 & displaying the sender information in fig. 7), and the access determining unit determines not to allow access to the image data when the transmission source or the transmission destination of the image data indicated by the communication details is a preselected transmission source or a preselected transmission destination (note that a particular user is not allowed to access/retrieve the fax data of other preselected user according to col. 8, lines 23-48).

With respect to claim 4, Bobo discloses the communication system according to claim 1, further comprising a second storage commanding unit that stores image data and communication details associated with the image data in the image storing unit when the image data is transmitted or received through facsimile communications (unit

for commanding to store the received fax in accordance with the intended recipient in col. 8, lines 5-7), wherein the access determining unit determines whether to allow access to the image data associated with the communication details based on the communication details stored in the image storing unit (the user's mailbox is accessed only to the intended recipient upon entering the ID and password in col. 8, lines 23-35).

With respect to claim 5, Bobo discloses the communication system according to claim 4, wherein the second storage commanding unit stores the communication details associated with the image data for which the access determining unit determines to allow access in the image storing unit in a state capable of identifying that access is allowed (note that the recipient information in col. 8, line 7 and the sender information shown in fig. 7 are stored in MSDS 10 to allow access by the intended recipient in col. 8, lines 23-36), and stores the communication details associated with the image data for which the access determining unit determines not to allow access in the image storing unit in a state capable of identifying that access is not allowed (note that the recipient information in col. 8, line 7 and the sender information shown in fig. 7 are stored in MSDS 10 even if unauthorized user is trying to access the information in col. 8, lines 23-36).

With respect to claim 14, Bobo discloses a communication device (message storage and delivery system 10 in fig. 1) connected to and capable of performing data communications with a terminal device (communicating with PC 32 in fig. 1), the communication device comprising:

an image storing unit that stores image data (storing message data in col. 8, lines 5-7) transmitted or received through facsimile communications (note that the message data is fax data in col. 7, lines 60-64);

a page generating unit that generates a list page, the list page being a web page displaying a list of communication details associated with the image data transmitted or received through the facsimile communications (generating/displaying the list of faxes in thumbnail view in a webpage/HTML files in col. 10, lines 46-56 & col. 9, lines 39-50), the list of communication details including hyperlinks to the associated image data stored in the image storing unit (thumbnail view having the links to the corresponding pages in col. 10, lines 52-56); and

an access determining unit that determines whether to allow access to the image data associated with the communication details of the facsimile communication based on contents of the communication details (note that based on the intended recipient of the message in col. 8, line 7, the message is stored in the recipient's database/mailbox for retrieval in col. 8, lines 23-36), wherein the page generating unit generates the list page having the hyperlinks only to the image data for which the access determining unit allows access (generated webpage only contains hyperlinks of the fax image data of the intended recipient in col. 8, lines 59-65).

With respect to claim 15, Bobo discloses the communication device according to claim 14, wherein the communication details include at least a transmission source and transmission destination of the image data (identifying the intended recipient in col. 8, line 7 & displaying the sender information in fig. 7), and the access determining unit

determines not to allow access to the image data when the transmission source or the transmission destination of the image data indicated by the communication details is a preselected transmission source or a preselected transmission destination (note that a particular user is not allowed to access/retrieve the fax data of other preselected user according to col. 8, lines 23-48).

With respect to claim 19, Bobo discloses a terminal device (message storage and delivery system 10 in fig. 1) connected to and capable of performing data communications with a communication device (communicating with PC 32 in fig. 1), the terminal device comprising:

a page generating unit that generates a list page, the list page being a web page displaying a list of communication details associated with image data transmitted or received through facsimile communications (generating/displaying the list of faxes in thumbnail view in a webpage/HTML files in col. 10, lines 46-56 & col. 9, lines 39-50), the list of communication details including hyperlinks to the associated image data (thumbnail view having the links to the corresponding pages in col. 10, lines 52-56), wherein the page generating unit generates the list page having the hyperlinks only to the image data for which access is allowed (the mailbox can be only accessed by the intended recipient using the password and ID in col. 8, lines 23-36); and

a page distributing unit that distributes via a network the list page generated by the page generating unit (system 10 distributing the browser page to the user computer for review in col. 8, lines 23-36).

With respect to claim 22, arguments analogous to those presented for claim 14, are applicable.

With respect to claim 24, Bobo discloses a storage medium that stores a program for controlling a terminal device (message storage and delivery system 10 in fig. 1) connected to and capable of performing data communications with a communication device (communicating with PC 32 in fig. 1), the program comprising:

a program of generating a first list page, the first list page being a web page displaying a list of communication details associated with image data transmitted or received through facsimile communications (generating/displaying the first list of faxes of user A in thumbnail view in a webpage/HTML files in col. 10, lines 46-56 & col. 9, lines 39-50), the list of communication details including hyperlinks to the associated image data (thumbnail view having the links to the corresponding pages in col. 10, lines 52-56);

a program of generating a second list page having the hyperlinks only to the image data for which access is allowed (generating the webpage having the fax list for user B who is allowed the access to view and retrieve his/her fax image in col. 10, lines 46-56 & col. 9, lines 39-50); and

a program of distributing via a network the second list page (system 10 distributing the browser page to the user computer for review in col. 8, lines 23-36).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bobo in view of Thames et al. U.S. Patent Application Pub. No. 2003/0145281 (hereinafter Thames).

With respect to claim 7, Bobo discloses a communication system comprising a communication device (message storage and delivery system 10 in fig. 1) and a terminal device (PC 32 in fig. 1) connected to each other to be capable of performing data communications therebetween (communicating with each other via the network in fig. 1), wherein the communication device comprises:

an image storing unit that stores image data (storing message data in col. 8, lines 5-7) transmitted or received through facsimile communications (note that the message data is fax data in col. 7, lines 60-64);

a page generating unit that generates a list page, the list page being a web page displaying a list of communication details associated with the image data transmitted or received through the facsimile communications (generating/displaying the list of faxes in thumbnail view in a webpage/HTML files in col. 10, lines 46-56 & col. 8, lines 23-36), the list of communication details including hyperlinks to the associated image data stored in

the image storing unit (thumbnail view having the links to the corresponding pages in col. 10, lines 52-56); and

an access determining unit that determines whether to allow access to the image data associated with the communication details of the facsimile communication based on contents of the communication details (note that based on the intended recipient of the message in col. 8, line 7, the message is stored in the recipient's database/mailbox for retrieval in col. 8, lines 23-36), wherein the page generating unit generates the list page having the hyperlinks only to the image data for which the access determining unit allows access (generated webpage only contains hyperlinks of the fax image data of the intended recipient in col. 8, lines 59-65).

Bobo, however, does not explicitly disclose the terminal device comprising a page distributing unit that distributes via a network that list page generated by the page generating unit.

Thames discloses a display for displaying a webpage wherein the display includes a function for transmitting/distributing the displayed webpage via an email communication to other device (paragraph 957 & fig. 69A). Furthermore, the examiner notes that transmitting a displayed webpage via an email communication is well known in the Internet.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the PC 32 of Bobo to include the function of transmitting/distributing the displayed webpage (HTML) to another device via an email as taught by Thames.

The suggestion/motivation for doing so would have been to share the displayed webpage information with other user in the network.

Therefore, it would have been obvious combine Bobo with Thames to obtain the invention as specified in claim 7.

With respect to claim 8, Bobo discloses the communication system, wherein the communication details include at least a transmission source and transmission destination of the image data (identifying the intended recipient in col. 8, line 7 & displaying the sender information in fig. 7), and the access determining unit determines not to allow access to the image data when the transmission source or the transmission destination of the image data indicated by the communication details is a preselected transmission source or a preselected transmission destination (note that a particular user is not allowed to access/retrieve the fax data of other preselected user according to col. 8, lines 23-48).

4. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eguchi et al. U.S. Patent Application Pub. No. 2003/0117665 (hereinafter Eguchi) in view of Tanimoto U.S. Patent Application Pub. No. 2003/0103242.

With respect to claim 16, Eguchi discloses a communication device (facsimile apparatus 1 in fig. 2) connected to and capable of data communications with a terminal device (archive terminal device 18 in fig. 2), the communication device comprising:

a first storage commanding unit that stores image data transmitted or received through facsimile communications and communication details associated with the image

data in the terminal device (transmitting the image data and the communication detail to the archive terminal device in paragraph 113); and

an access determining unit that determines whether to allow access to the image data associated with the communication details of the facsimile communication based on contents of the communication details (unit for determining whether to archive the image data for later access/retrieval based on the contents of communication details in S204~S207 in fig. 12), wherein the access determining unit determines whether to allow access to the image data when the image data is transmitted or received through facsimile communications (executing the S204~S207 in fig. 12), wherein the first storage commanding unit stores only the communication details in the terminal device when the access determining unit determines not to allow access based on the communication details (creating an email for storing the communication detail without the image data attached in paragraph 112) and stores the communication details and the associated image data in the terminal device when the access determining unit determines to allow access based on the communication details (creating the email for archiving the image with the communication details in the terminal device in paragraph 113).

Eguchi, however, does not explicitly disclose the communication device comprising an image storing unit for storing the image data and the communication details.

Tanimoto discloses the communication device (facsimile apparatus 1 in fig. 11) comprising an image storing unit (archive device being placed in the facsimile apparatus

in fig. 1) for storing the image data and the communication details (paragraph 56 and fig. 3).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the facsimile apparatus of Eguchi to include the archive device as taught by Tanimoto.

The suggestion/motivation for doing so would have been to provide a facsimile apparatus for archiving the image data without requiring the LAN or other network archive device (paragraph 56 of Tanimoto).

Therefore, it would have been obvious to combine Eguchi with Tanimoto to obtain the invention as specified in claim 16.

With respect to claim 17, Tanimoto further discloses the communication device further comprising a second storage commanding unit that stores image data and communication details associated with the image data in the image storing unit when the image data is transmitted or received through facsimile communications (archive device being placed in the facsimile apparatus in fig. 1 for storing another image data and its communication details in paragraph 56 and fig. 3),

wherein the access determining unit determines whether to allow access to the image data associated with the communication details based on the communication details stored in the image storing unit (note that facsimile apparatus accepts a specified document among the list shown in fig. 3 to either print, display or transfer in paragraph 45. Based on the document selected, the facsimile apparatus having the archive device as shown in fig. 11 allows the access to the document).

Also, referring to the drawings (fig. 1) of the current invention there is only one storage commanding unit that stores image data in the RAM 140. Therefore, the first and the second commanding units are construed as the same part.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the facsimile of Eguchi to include the access allowing device in order to retrieve the archived documents for printing or displaying (paragraph 45 of Tanimoto).

With respect to claim 18, Eguchi further discloses the communication device according to claim 17, wherein the second storage commanding unit stores the communication details associated with the image data for which the access determining unit determines to allow access in the archive unit in a state capable of identifying that access is allowed, and stores the communication details associated with the image data for which the access determining unit determines not to allow access in the archive unit in a state capable of identifying that access is not allowed (as noted above, the communication details are archived regardless of the access conditions in paragraphs 112 & 113).

5. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kida et al. U.S. Patent No. 5,293,253 (hereinafter Kida) in view of Oba et al. U.S. Patent No. 6,072,599 (hereinafter Oba).

With respect to claim 23, Kida discloses a storage medium that stores a program for controlling a communication device (receiving facsimile 21 in col. 9, line 66 & fig. 11) connected to and capable of performing data communications with a terminal

device (transmitting facsimile transmitting facsimile data to the receiving facsimile 21), the program comprising:

a program of storing image data transmitted or received through facsimile communications (it is inherent that the facsimile 21 includes a storage means for storing the received facsimile data for printing or viewing in step V4 in col. 10, lines 5-11);

a program of storing image data transmitted or received through facsimile communications and communication details associated with the image data in an image storing unit provided in the communication device (inherently storing the station identification information for the comparison in step V3 in col. 10, lines 1-5 and storing the received facsimile data for printing or viewing in step V4 in col. 10, lines 5-11);

a program of determining whether to allow access to the image data associated with the communication details of the facsimile communication based on contents of the communication details (analyzing the received station identification information for determining whether to allow the transmission/printing of the image data in col. 10, lines 1-5);

a program of storing only the communication details in the image storing unit when access is not allowed based on the contents of the communication details (note that only the station identification information of the rejected communication is stored for displaying or printing in col. 10, lines 20-35); and

a program of storing the associated image data in the image storing unit when access is allowed based on the contents of the communication details (when it is

allowed the received fax data is stored for printing or viewing by the user in col. 5, lines 11) .

Kida, however, does not explicitly disclose that the image storing unit stores the communication details and the associated image data when access is allowed.

Oba discloses a facsimile device for receiving a facsimile data and storing both the received facsimile data for printing and the communication details (the sender's phone number) for printing out the communication history (printing out the facsimile reception history including the stored identification of the called stations in fig. 20).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the facsimile of Kida to store both the received facsimile data for printing and the communication details as taught by Oba.

The suggestion/motivation for doing so would have been to print out the communication history including the sender's information.

Therefore, it would have been obvious to combine Kida with Oba to obtain the invention as specified in claim 23.

Allowable Subject Matter

6. Claims 9-13 are allowed.

7. Claims 3, 6, 20 and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record do not teach or suggest a communication system comprising a communication device and a terminal device wherein the communication device comprises a first storage commanding unit for storing only the communication details in the image storing unit when the access determining unit determines not to allow access based on the communication details and storing the communication details and the associated image data in the storing unit when the access determining unit determines to allow access based on the communication details wherein a page generating unit generates the list having the hyperlinks only to the image data for which the access determining unit allows access as claimed in claim 3 and 9.

Furthermore, the prior art of record do not teach or suggest the page distributing unit for distributing the first list page unconditionally and distributing the second list page only when specific distribution conditions have been met as claimed in claim 6 and 20.

The features identified, in combination with other claim limitations, are neither suggested nor discussed by the prior art of record.

Contact Information

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571)272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CHAN S PARK/
Examiner, Art Unit 2625

March 18, 2008